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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,038	12/11/2003	Jonathan T. Zempel	LOT920030019US	8720
45544 7590 08/30/2007 HOFFMAN, WARNICK & D'ALESSANDRO LLC 75 STATE ST 14TH FLOOR ALBANY, NY 12207			EXAMINER BETIT, JACOB F	
			ART UNIT 2164	PAPER NUMBER
			MAIL DATE 08/30/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/734,038

Applicant(s)

ZEMPEL, JONATHAN T.

Examiner

Jacob F. Bétit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remarks

1. In response to communications filed on 20 June 2007, claims 1, 9, 14, and 18 are amended per applicant's request. Claims 1-20 are presently pending in the application.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 14-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The applicant's invention appears to be directed to a system that is made of only software instructions. Software instructions cannot be fit into one of the four categories of invention and therefore this claim is not statutory. Software instructions are not a series of steps or acts and thus is not a process. Software instructions are not a physical article or object and as such is not a machine or manufacture. Software instructions are not a combination of substances and therefor not a composition of matter.

4. Claims 18-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In paragraph 0020 of the specification the applicant has provided evidence that the applicant intends the medium to include transmission signals as such the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim is not statutory. Energy is not a series of steps or acts and thus is not a

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process. Energy is not a physical article or object and as such is not a machine or manufacture.

Energy is not a combination of substances and therefor not a composition of matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Redmond et al. (U.S. patent application publication No. 2002/0095401 A1).

As to claim 1, Redmond et al. teaches a method of tracking data, the method comprising:
receiving a request from a client, wherein the request is at least one of: providing update data for a tracked data item or requesting data for the tracked data item (see paragraphs 0040-0041);

selecting a handler based on the tracked data item (see paragraph 0042);

obtaining response data from a data application based on the tracked data item (see paragraph 0050);

generating a response based on the response data using the handler (see paragraph 0055-0056);

storing the response in a recordable medium (0056, where it is implicit that if a response is transmitted to a client, the client will store it in some kind of memory when it is received, further it is implicit that the message exists somewhere in memory before it is transmitted).

As to claim 2, Redmond et al. teaches further comprising providing the response to the client (see paragraph 0056).

As to claim 3, Redmond et al. teaches wherein the selecting step is further based on the client (see paragraph 0044).

As to claim 4, Redmond et al. teaches wherein the obtaining step includes:
retrieving a trackable object associated with the tracked data item (see paragraph 0042);
and
providing the trackable object to the data application (see paragraph 0045-0047).

As to claim 5, Redmond et al. teaches wherein the obtaining step includes:
retrieving at least one measurable objective associated with the tracked data item (see paragraph 0035 and paragraph 0040); and
providing the at least one measurable objective to the data application (see paragraph 0040).

As to claim 6, Redmond et al. teaches wherein the generating step includes:
obtaining format data based on a response format (see paragraph 0041); and
formatting the response data using the format data (see paragraph 0043).

As to claim 7, Redmond et al. teaches wherein the format data defines a predefined tracking standard (see paragraph 0042).

As to claim 8, Redmond et al. teaches wherein the generating step includes:
obtaining client data based on the client (see paragraph 0050); and
formatting the response data using the client data (see paragraphs 0050-0052).

As to claim 9, Redmond et al. teaches a method of tracking data, the method comprising:
receiving a request from a client, wherein the request is at least one of: providing update data for a tracked data item or requesting data for the tracked data item (see paragraphs 0040-0041);

selecting a handler based on the tracked data item and the client (see paragraph 0042);
obtaining response data for the tracked data item from a data application (see paragraph 0050);

generating a response based on the response data using the handler (see paragraph 0055);
and

providing the response to the client (see paragraph 0056).

As to claim 10, see the citations directed to claim 4 above.

As to claim 11, see the citations directed to claim 5 above.

As to claim 12, see the citations directed to claim 6 above.

As to claim 13, see the citations directed to claim 8 above.

As to claim 14, Redmond et al. teaches a system for tracking data, the system comprising:
at least one handler for processing a request that is at least one of: providing update data for a tracked data item or requesting data for the tracked data item (see paragraphs 0040-0042);
and

a management system for receiving the request from a client and selecting one of the at least one handlers based on the tracked data item (see paragraph 0042);

wherein the selected handler obtains response data for the tracked data item, generates a response based on the response data, and stores the response in a recordable medium (see paragraphs 0050 and 0055-0056).

As to claim 15, Redmond et al. teaches further comprising a data application for providing the response data to the selected handler (see paragraph 0056).

As to claim 16, Redmond et al. teaches further comprising a client system for providing client data based on the client (see paragraph 0044).

As to claim 17, Redmond et al. teaches further comprising a format system for providing format data based on a predefined tracking standard (see paragraph 0042).

As to claim 18, Redmond et al. teaches a program product stored on a recordable medium for tracking data, which when executed comprises:

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program code for receiving a request from a client, wherein the request is at least one of: providing update data for a tracked data item or requesting data for the tracked data item (see paragraphs 0040-0041);

program code for selecting a handler based on the tracked data item and the client (see paragraph 0042);

program code for obtaining response data for the tracked data item from a data application (see paragraph 0050);

program code for generating a response based on the response data using the handler (see paragraph 0055); and

program code for providing the response to the client (see paragraph 0056).

As to claim 19, Redmond et al. teaches further comprising: program code for retrieving at least one of:

a trackable object and at least one measurable objective associated with the tracked data item (see paragraph 0035); and

program code for providing the at least one of: a trackable object and at least one measurable objective to the data application (see paragraphs 0035 and 0040).

As to claim 20, Redmond et al. teaches further comprising:

program code for obtaining format data based on a response format (see paragraph 0041);

program code for obtaining client data based on the client (see paragraph 0050); and

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program code for formatting the response data using the format data and the client data (see paragraphs 0043 and 0050-0052).

Response to Arguments

7. Applicant's arguments filed 20 June 2007 have been fully considered but they are not persuasive.

In response to the applicant's arguments that "an embodiment of the claimed system for tracking data is clearly shown and described as including both a server and program code", the arguments have been considered, but are not deemed persuasive. MPEP 2106 II. C. states

The claims define the property rights provided by a patent, and thus require careful scrutiny. The goal of claim analysis is to identify the boundaries of the protection sought by the applicant and to understand how the claims relate to and define what the applicant has indicated is the invention. *USPTO< personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. See *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) ("[T]he name of the game is the claim.").

Therefore, when looking at the property rights that would be provided by a patent of claims 14-17, every embodiment must be considered. One embodiment involves the system being nothing more than a series of instructions (software) as disclosed in paragraph 0031 ("It is understood that the present invention can be realized in hardware, *software*, or a combination of hardware and software" emphasis added). Since one disclosed embodiment involves a system made up of software instructions and these software instructions alone do not fall in a statutory category under 35 USC §101, claims 14-17 are claiming features which are outside the boundaries allowed by 35 USC §101.

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In response to the applicant's arguments that "[t]he Supreme Court has stated that the text of 35 U.S.C. §101 is intended to 'included 'anything under the sun that is made by man' as statutory subject matter", the arguments have been considered, but are not deemed persuasive.

MPEP 2106 IV A. states

Federal courts have held that 35 U.S.C. 101 does have certain limits. First, the phrase "anything under the sun that is made by man" is limited by the text of 35 U.S.C. 101, meaning that one may only patent something that is a machine, manufacture, composition of matter or a process. See, e.g., *Alappat*, 33 F.3d at 1542, 31 USPQ2d at 1556; *Warmerdam*, 33 F.3d at 1358, 31 USPQ2d at 1757 (Fed. Cir. 1994). Second, 35 U.S.C. 101 requires that the subject matter sought to be patented be a ">new and< useful" invention. Accordingly, a complete definition of the scope of 35 U.S.C. 101, reflecting Congressional intent, is that any new and useful process, machine, manufacture or composition of matter under the sun that is made by man is the proper subject matter of a patent.

In response to the applicant's arguments that, "the claimed invention clearly comprises a manufacture", the arguments have been considered, but are not deemed persuasive. While a machine produces the claimed propagated signal, this signal is not a product. A propagated signal unlike a CD-ROM or similar storage medium does not store data. You cannot sell someone a wave with a program on it. You sell them a copy of that program that is stored on their computer. A propagated signal would be considered a service that us used to get that program to the computer so that it can be stored (i.e. you subscribe to the Internet as a service not buy it as you would a product). The propagated signal is used to generate a copy of the program, but it is not itself a copy of that program. A difference between a product and a propagated signal is that someone can buy a product, and even if they do not have the means to use the product, they can keep it until they do. If someone buys a signal, they cannot hold onto it until they have the means to use that signal. Further it is noted it is unlikely that the entire program

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would exist as a signal at one time. Instead part of the program would be being converted to a signal while another part is being received by a remote computer.

In response to the applicant's arguments that "the Guidelines are not controlling law", the arguments have been considered, but are not deemed persuasive. Although the guidelines do not have the "force and effect of law" (MPEP 2106), they are found in the Manual of Patent Examining Procedures and therefore must be used by Patent Examiners when interpreting claim language. Further since the Examiner lacks the authority to disregard what is specifically stated in the MPEP, it is respectfully requested that any further issues with the "Interim Guidelines" be appealed to a body with sufficient authority to consider these issues.

In response to the applicant's arguments that "Applicant submits that the Court held that software embodied in an electronic transmission may qualify as a "component" under § 271(f)", the arguments have been considered, but are not deemed persuasive. It is noted that the claims are rejected under 35 USC §101 and therefore interpretation of what can be considered a component (a part of the invention) under 35 USC §271 is irrelevant. Although the Federal Circuit has held that "every form of invention eligible for patenting falls within the protection of section 271(f)", the applicant is in error when stating the converse of this statement. The applicant states "everything protectable under 35 U.S.C. §271(f) is eligible for patenting under 35 U.S.C. §101." There is no rule in logic that allows this statement to be derived from the Federal Circuit's statement. The converse of the Federal Circuit's statement would be that some of what is covered under 35 U.S.C. §271 is eligible for patenting. The applicant's statement is definitely

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false in this case since §271(f) deals with not only with complete inventions but “substantial portion of the components” of those inventions. Again, what is at issue in the 35 USC §101 rejection is not part of the invention (a component), but the invention taken as a whole.

In response to the applicant’s arguments that “Redmond fails to disclose, *inter ali*, selecting a handler based on a tracked data item included in a request received from a client”, the arguments have been considered, but are not deemed persuasive. According to paragraph 0042 the SAO is an object that understands how student tracking information is stored in a particular type of learning management database. Therefore the particular SAO being used is chosen based on how the “tracked data item” is being stored in the database. This is a property of the “tracked data item” and therefore one could say the SAO is being chosen based on the “tracked data item”. Further as indicated by the applicant “the SAO is typically selected using ‘two fields [in the request] indicated what product (and from which vendor) has sent the request’”. These two fields indicated what product and vendor the client is using to send the update or read request which in term indicate what format any updated information would be sent in. Surely while doing a update request from a client using a particular product to send the update, the SAO would be chosen based on the “tracked data item” being updated.

In response to the applicant’s arguments that the applicant has amended the claims to “further clarify that the request is providing updated data for the tracked data item and/or request data for the tracked data item”, the arguments have been considered, but are not deemed persuasive. Paragraph 0041 states that the database operations are either writes or reads. A write

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would be a update of a data item, and a read would be a request for data from the database about the status of a data item.

The applicant states, "Applicant respectfully requests that the Office clarify what corresponds to the claimed 'tracked data item' in Redmond". In response it is noted that the tracked data item is the item in the database that the client is attempting to read or write to. As indicated by Redmon in paragraph 0042 the information that is being stored and accessed is "student tracking information". Therefore, a tracked data item could be a record corresponding to a user's grades or a particular test. This data is being tacked by a "student tracking database" to ensure that a student properly completes an online course.

In response to the applicant's arguments that "Redmond fails to disclose selecting the handler based on the tracked data item and the client", the arguments have been considered, but are not deemed persuasive. The SAO is selected based on both what database the request is directed towards and what product the client uses to make the request (i.e., the handler is selected based on both where the data item is coming from and where it is going). Redmond teaches enabling the administrator to override where the tracked data item comes from (i.e., player X, the client) and instead use Y SAO. Therefore after the administrator has changed the "redirect.dat" file all requests coming from the client that uses player X will be handled by Y SAO. Not only is the SAO determined by Redmond based on the client, but also the administrator is able to change which handler is used by using the "redirect.dat" file.

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Conclusion


8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob F. B  tit whose telephone number is (571) 272-4075. The examiner can normally be reached on Monday through Friday 9:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

jfb
21 Aug 2007


CHARLES RONES
SUPERVISORY PATENT EXAMINER